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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,442	03/04/2002	Hideaki Hirai	R2184.0137/P137	4020
24998	7590	04/28/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			HINDI, NABIL Z	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	

2655

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,442

Applicant(s)

HIRAI ET AL.

Examiner

NABIL Z HINDI

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-82 is/are pending in the application.
- 4a) Of the above claim(s) 5,8 and 14-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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In response to applicant's amendment dated April 12, 2005. The following action is taken:

Claims 1, 3, 4, 6, 7, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not disclose the use of a "non-polarization type beam light path splitting part" as now claimed in claim 1. The embodiment of the claimed invention is directed to fig 3 as stated in response to the restriction requirement. It is noted that the dichroic element is the same as the non-polarization element. However the fig nor the specification does not show the use of both within the same embodiment.

Claims 11-13 are rejected for the same reasons set forth in the previous office action repeated herein for applicant's convenience.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ju et al (5974020).

The reference shows an optical disk reading apparatus comprising a first and second light sources 51, 52, first and second photo detection elements 563, 564, a polarizing light beam splitter 56 for splitting the light beam emitted from the first light source, a non-polarizing beam splitter (dichroic prism 55) for splitting the light beam emitted from the second light source, a $\frac{1}{4}$ wave plate 57, a first and second light combining prism 59 and a light converging element (objective lens) 560.

With respect to the limitations of claims 12 and 13. The reference shows the use of a $\frac{1}{4}$ wave plate which the same structural element disclosed in the invention.

Claim 82 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the cited prior art shows or teaches an optical head having the structural elements as claimed.

Applicant's arguments with respect to claims 1, 3, 4, 6, 7, 9-13 and 82 have been considered but are moot in view of the new ground(s) of rejection.


Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on April 12, 2005 prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, THIS

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ACTION IS MADE FINAL. See MPEP § 706.02(I)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to NABIL Z HINDI at telephone number (571) 272-7618.


NABIL HINDI
PRIMARY EXAMINER
GROUP 2E00
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